

Serial No. 08/963,096
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REMARKS/ARGUMENTS

The Examiner rejects claims 94 and 97 under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention and for the inclusion of new matter.

Applicants respectfully disagree with the Examiner's new matter rejection but have cancelled Claims 94 and 97 in order to expedite prosecution.

The Examiner rejects claims 90-93 and 95-96 under 35 U.S.C. 112, first paragraph, "because the specification, while being enabling for claims limited to Agrobacterium-mediated transformed maize inbreds PHJ90, PHN46, and PHP28(38) prepared by the disclosed method, does not reasonably provide enablement for claims broadly drawn to any Agrobacterium-mediated transformed maize inbred which is not A188." The Examiner invited the Applicant to submit a declaration to support the assertion that the three inbreds belong to different heterotic groups, and to explain why an assignment to different heterotic groups is an indication of genetic diversity.

Applicants traverse but have amended Claims 90, 92 and 95; and cancelled Claims 93 and 96 in order to expedite prosecution.

The Examiner rejects claims 90-93 and 95-96 under 35 U.S.C. 102(b) as being anticipated by Goldman et al. (U.S. Patent 5,177,010). The Examiner rejects claims 90-93 and 95-96 under 35 U.S.C. 102(e) as being anticipated by Goldman et al. (U.S. Patent 6,020,539). The Examiner maintains that the particular explant used for inoculation with Agrobacterium, in order to make the claimed Agrobacterium-transformed maize plants (which would inherently contain at least one 25 base-pair T-DNA border sequence), would not confer a patentable distinction to the resultant Agrobacterium-transformed maize plant.

Applicants traverse but have amended Claims 90, 92 and 93 and cancelled Claims 93 and 96 in order to expedite prosecution.

The Examiner rejects claims 92 and 95 under 35 U.S.C. 102(a) as anticipated by Ishida et al. (Nature Biotech. 14:745-750, 1996).

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Applicants traverse the rejection but have amended the claims in order to expedite prosecution.

The Examiner rejects claims 92 and 95 under 35 U.S.C. 102(b) as being anticipated by Gould et al.

Applicants traverse the rejection but have amended the claims in order to expedite prosecution.

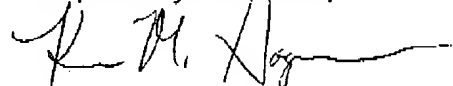
The Examiner rejects claims 90, 92-93 and 95-96 under 35 U.S.C. 102(b) as being anticipated by and under 35 U.S.C. 103(a) as being unpatentable over each of Schlappi et al., Grimsley et al. (1988), and Ritchie et al.

Applicants traverse the Examiner's rejection but have amended Claims 90, 92 and 95; and cancelled Claims 93 and 96 in order to expedite prosecution.

CONCLUSION

Applicants have amended claims 90, 92 and 95. Applicants have cancelled claims 93, 94, 96 and 97. Claims 90-92, and 95 now remain. In light of the foregoing amendments allowance of all remaining claims is respectfully requested.

Respectfully submitted,



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